

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed February 24, 2005. In the Office Action, claims 1-5, 9-11, and 15-18 were rejected under 35 U.S.C. §102, and claims 6, 7, 8, 12, 13, 14, and 19 were rejected under 35 U.S.C. §103. Reconsideration in light of the amendments and remarks made herein is respectfully requested. Claim 23 has been added.

Rejection Under 35 U.S.C. § 102

Claims 1-5, 9-11, and 15-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Barkan (U.S. Patent No. 6,572,020). Applicant respectfully traverses the rejection because a *prima facie* case of anticipation has not been established for claims 9-11 and claims 15-18. Independent claim 1 has been revised for further discussion of the grounds for traversing the §102(e) rejection as applied to claims 1-5 is moot.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

It is noted that the Office Action merely identifies certain column numbers within Barkan as teaching certain elements of various claims, but does not identify where the teachings of each and every claimed element may be found in Barkan. Such communication of the basis for a rejection is important because it gives the Applicants a fair opportunity to reply. *See MPEP 706.02(j)*. The relevant teachings of the prior art relied upon should be set forth in the Office Action, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate. *See MPEP 706.02(j)*. Hence, Applicants respectfully request that any future Office include the recitation of specific language, clearly pointing out element by element, what elements of Barkan allegedly give rise to a rejection of Applicant's claimed invention. Such information would greatly facilitate prosecution of the subject application.

With respect to independent claim 9, Applicants respectfully submit that Barkan does not describe an internal memory that "comprises a plurality of data storage groupings including (1) a first data storage grouping being a list of coupons, inaccessible for redemption, that are currently available for a particular geographic region, and (2) a second data storage grouping being a list of coupons, accessible for redemption, that were scanned and matched with a coupon of the first data storage grouping." In fact, Applicants have been unable to uncover any teaching or suggestive language within Barkan of segregating areas of memory based on grouping as claimed. Withdrawal of the §102 rejection as applied to claims 9-11 is respectfully requested.

With respect to independent claim 15, Applicants respectfully submit that Barkan does not describe a portable scanner system utilizing a portable scanner that comprises internal memory to store (i) a plurality of electronic coupons stored as coupon barcodes and (ii) *retail store program (RSP) information including store credit accessible only by the in-store server if*

the in-store server uploaded the RSP information into the portable scanner. Emphasis added. Instead, Barkan is directed to electronic coupon scanner with electronic coupon downloading capabilities only, in contrast with the portable scanner that operates as a “club” card with coupon scanning capabilities as well.

Moreover, Barkan does not teach or even suggest the portable scanner operating as a front-line validation system as explicitly claimed in new claim 23.

In light of the foregoing, withdrawal of the §102(e) rejection as applied to claims 1-5, 9-11, and 15-18 is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 6, 7, 8, 12, 13, 14, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barkan. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Moreover, Applicants traverse the Official Notice taken with respect to claims 6-8, 12 and 19. It is noted that the Office Action is devoid of any argument directed to the lack of allowability of these claims. Hence, Applicants cannot properly respond, and thus, any subsequent rejection (if any) should not be final in accordance with MPEP §706.07(a).

For instance, Barkan does not suggest comparing the manufacturer code from the coupon barcode with a product barcode read by the POS system, *and if a match*, analyzing each field of the coupon barcode, including a value code, an offer code, an expiration code, *and any terms and conditions associated with the coupon barcode*, to verify that a purchased product meets terms set by the coupon barcode. Emphasis added. A similar argument can be made for the allowability of claim 19.

Additionally, with respect to claim 8, Barkan does not teach or suggest processing of the scanned barcode being a coupon barcode further comprises redeeming of the scanned coupon further comprises *generating a detailed proof of purchase for every coupon redemption transaction, the proof of purchase comprises* (i) a date stamp, (ii) a time stamp, (iii) a retail store location where the coupon was redeemed and aisle location of a product purchased, (iv) an original selling price of the purchased product, (v) a face value of the scanned coupon redeemed, and (vi) additional discounts offered by the retailer. Rather, Barkan is devoid of any teachings of a proof of purchase as claimed.

With respect to claim 12 for example, Barkan teaches an optical code reader (30) that is devoid of any display. It is not obvious to provide the display because optical code reader (30) of Barkan does not appear to utilize and store coupon descriptive information such as alphanumeric characters or graphic image used to describe the nature of the coupon.

In summary, Applicants respectfully request withdrawal of the §103(a) rejection based on the lack of a *prima facie* case of obviousness.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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July 25, 2005

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